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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,575	02/15/2001	Tim Cantrell	23101.0003U1	1832

23859 7590 11/27/2006

NEEDLE & ROSENBERG, P.C.  
SUITE 1000  
999 PEACHTREE STREET  
ATLANTA, GA 30309-3915

EXAMINER
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WILSON, MICHAEL C

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

1/1

<b>Office Action Summary</b>	<b>Application No.</b> 09/784,575	<b>Applicant(s)</b> CANTRELL ET AL.	
	<b>Examiner</b> Michael C. Wilson	<b>Art Unit</b> 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 59-62, 64, 65 and 88-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-62 64 65 88-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-11-06 has been entered.

Claims 1-58, 63 and 66-87 have been canceled. Claims 88-94 have been added. Claims 59-62, 64, 65 and 88-94 are pending and under consideration in the instant office action.

Applicant's arguments filed 7-11-06 have been fully considered but they are not fully persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Support for the amendment in claims 59, 64 and 65 and in new claims 88-90 is found in the paragraph bridging pg 11-12 states:

"In another embodiment, the present invention provides an oviposited avian egg comprising a native embryo having fewer than 40,000 cells, wherein the embryo can develop into a live chick. "Native" means growing, living or produced in its place of origin. Thus a native embryo is an embryo that develops and hatches in the same shell in which the female pronucleus was formed. Thus, the embryo is descended from the native ovum. By the time an ovum which has been fertilized naturally has been oviposited, the developing embryo typically has between 40,000 and 70,000 cells. However, the egg of the present invention is fertilized after it has been oviposited in its shell", thus, an embryo developing in the egg of the present invention will at some time during incubation have fewer than 40,000

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cells. In fact, at the moment of activation, the embryo in the egg of the present invention will have one cell and is a zygote."

***Claim Rejections - 35 USC § 112 - New Matter***

Claim 94 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Support for the phrase "wherein the embryo resulted from the joining of a female and male pronucleus" in claim 94 has not been provided and cannot be found.

***Claim Rejections - 35 USC § 102***

The rejection of claims 59-62, 64 and 65 under 35 U.S.C. 102(b) as being anticipated by Tanaka (1994, J. Reprod. Fert., Vol. 100, pg 447-449) has been withdrawn in view of the amendment. Tanaka taught an oviposited chicken egg comprising a fertilized ovum (pg 447, col. 2, "Materials and Methods"; pg 448, Fig. 1) made by transferring a day old fertilized ovum into the birth canal of the chicken. A shell formed around the fertilized ovum as it passed through the recipient hen's reproductive system, the egg was laid on the day following the transfer (pg 448, col. 1, line 4) and a chick hatched (pg 448, col. 2, first full ¶, line 9). However, the embryo did not develop and hatch from the same shell in which the female pronucleus was formed as claimed.

The rejection of claims 59-62, 65 and 65 under 35 U.S.C. 102(b) as being anticipated by Johnston (1998, Poultry Science, Vol. 77, pg 142) has been withdrawn in

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view of the amendment. Johnston taught an oviposited oocyte with a shell used for fertilization by injecting sperm onto the oocyte (line 9 and 6 lines from the bottom), which is equivalent to an oviposited chicken egg comprising a shell and an embryo as claimed. However, Johnston taught the embryo was in a shell and then removed, which does not meet the limitation of an embryo that "develops and hatches from the same shell in which the female pronucleus was formed" as claimed.

The rejection of claims 59-65 under 35 U.S.C. 102(b) as being anticipated by Naito (1990, J. Exp. Zoo., Vol. 254, pg 322-326) as supported by Olsen (J. Morph., 1942, Vol. 70, pg 513-533, Ref DC in the IDS filed 9-4-01) has been withdrawn in view of the amendment. Naito did not teach the embryo developed and hatched in the same shell in which the female pronucleus was formed.

### **Claim Rejections - 35 USC § 103**

The rejection of claims 59-65 under 35 U.S.C. 103(a) as being unpatentable over Johnston (1998, Poultry Science, Vol. 77, pg 142) in view of Goldberg (1992, Ped. Research, Vol. 32, pg 23-26) has been withdrawn in view of the amendment.

### **Double Patenting**

Claim 88 and 91 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 59. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 89 and 92 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 64. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 90 and 93 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 65. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

## Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Perry of record (1988, Nature, Vol. 331 , pg 70-72). Perry taught a fertilized oocyte recovered from the magnum of a killed hen surrounded by a capsule of dense viscous albumen (pg 71, Fig. 1A caption). The specification states "reference to an avian egg in a shell refers to an oviposited egg, that is, an egg with a calcium carbonate shell that has been extruded from the vagina of the bird" (pg 7, lines 23-25). Perry does not apply as art because the fertilized oocyte isolated by Perry was not "oviposited" as claimed, i.e. not an egg with a calcium carbonate shell extruded from the vagina of the bird.

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No claim is allowed.

Inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson who can normally be reached at the office on Monday, Tuesday, Thursday and Friday from 9:30 am to 6:00 pm at 571-272-0738.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Peter Paras, can be reached on 571-272-4517.

The official fax number for this Group is (571) 273-8300.

Michael C. Wilson



**MICHAEL WILSON  
PRIMARY EXAMINER**